



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/827,559	04/19/2004	Yoshiki Katoh	4041J-000859	4409

27572 7590 01/11/2008
HARNES, DICKEY & PIERCE, P.L.C.
P.O. BOX 828
BLOOMFIELD HILLS, MI 48303

EXAMINER

FORD, JOHN K

ART UNIT	PAPER NUMBER
----------	--------------

3744

MAIL DATE	DELIVERY MODE
-----------	---------------

01/11/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/827,559	Applicant(s) KATOH ET AL.	
	Examiner John K. Ford	Art Unit 3744	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 2 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 9/26/07
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☒ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12, 15-25 and 39 is/are pending in the application.
- 4a) Of the above claim(s) 4-12, 15-20, 23-25 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-3, 21, 22 and 39 is/are allowed (provisimally - see office action)
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>10/30/2007</u> | 6) <input type="checkbox"/> Other: _____ |

Applicant's response of September 26, 2007 has been studied carefully.

The drawing changes (Replacements Sheets) are approved and accepted. Subsequent to that September 26, 2007 response applicant sent in for consideration an IDS (dated October 30, 2007) and a translation of a somewhat detailed "Notice of Reason(s) for Refusal" apparently authored by the JPO on September 18, 2007. It would have been helpful if applicant's September 26, 2007 response in the US case discussed the September 18, 2007 communication from the JPO in the corresponding JP case, however given the closeness in time of these communications the delay is entirely understandable. The problem this examiner is having is that without a copy of the claims that the JPO was examining, it is impossible to comprehend the rejection(s) that the JPO was making in their translated office action.

As well, it is also noted that at least two documents that the JPO relied upon have not been made of record (JP 2000-318443 and JP H05-118706). The examiner assumes, consistent with applicant's past practice, that some of the English language references made of record (now or before) may be equivalents of the JP documents (i.e. JP 2000-318443 and JP H05-118706), however applicant's IDS gives no indication of what that correspondence, if any, actually is. Notwithstanding that there may be equivalents in the file, applicant is required to provide copies of the aforementioned documents (JP 2000-318443 and JP H05-118706) as well as to identify any English language equivalent. Applicant is also required to provide at the same time a copy (in English) of the claims that the JPO was examining at the time that they prepared their September 18, 2007 rejection.

But for not being able to understand the JPO office action, for the reasons stated above, which applicant will remedy in response to this office action, the examiner believes the claims to be provisionally allowable. The allowability is provisional because the examiner does not yet have the necessary materials to fully comprehend the JPO rejection.

This application is in condition for allowance except for the following formal matters: applicant is required to provide copies of the aforementioned documents (JP 2000-318443 and JP H05-118706) as well as to identify any English language equivalent. Applicant is also required to provide at the same time a copy (in English) of the claims that the JPO was examining at the time that they prepared their September 18, 2007 rejection.

Prosecution on the merits is closed in accordance with the practice under *Ex parte Quayle*, 25 USPQ 74, 453 O.G. 213, (Comm'r Pat. 1935).

A shortened statutory period for reply to this action is set to expire **TWO MONTHS** from the mailing date of this letter.

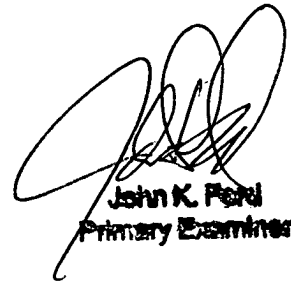
Any inquiry concerning this communication or earlier communications from the examiner should be directed to John K. Ford whose telephone number is 571-272-4911. The examiner can normally be reached on Mon.-Fri. 9-5:30.

Application/Control Number:
10/827,559
Art Unit: 3744

Page 4

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cheryl Tyler can be reached on 571-272-4834. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



John K. Ford
Primary Examiner